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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,525	03/01/2004	Rezvan Rooshenas	LCT100004000	2739

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EXAMINER
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FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/791,525

Applicant(s)

ROOSHENAS, REZVAN

Examiner

Michael J. Feely

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-15 is/are rejected.
- 7) ☒ Claim(s) 7-9 and 11-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040301.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 11-18 are objected to under 37 CFR 1.75(c) as being in improper form because a dependent claim cannot refer to two sets of claims to different features. See MPEP § 608.01(n).

Claims 11-18 should be rewritten in the style set forth in claim 10: --A method of applying a waterproofing composition to a substrate comprising: providing a substrate to be waterproofed; applying the composition of claim X (*X is 1-9*) to the substrate surface; and curing the composition.--

### *Claim Rejections - 35 USC § 102/103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, and 10-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gardner et al. (US Pat. No. 4,608,404).

Regarding claims 1-6 and 10-15, Gardner et al. disclose: *(1)* a composition (Abstract) comprising: a flexible epoxy resin (column 5, lines 1 through column 6, line 7); a flexible curing agent (column 2, line 10 through column 3, line 9); and an effective amount of poly (p-phenylene

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terephthalamide) polymer fiber ("p-aramid") and/or poly (m-phenylene terephthalamide) polymer fiber ("m-aramid") (column 10, lines 35-55); (2) further comprising an epoxy flexibilizer which is reacted when cured with the flexible epoxy resin (column 2, line 10 through column 3, line 9: *flexible hardener satisfies both of the "curing agent" and "flexibilizer"*); (3) further comprising an epoxy reactive diluent which is used to reduce viscosity of the composition (column 9, lines 18-22); (4) wherein the flexible epoxy resin is a glycol glycidyl ether (column 6, lines 5-7); (5) wherein the flexible curing agent is polyamine (column 2, line 10 through column 3, line 9); (6) wherein the polyamine is a polyetherpolyamine (column 2, line 10 through column 3, line 9); and

(10-15) a method of applying a composition to a substrate comprising: providing a substrate; applying the composition of any of claims 1-6 to the substrate surface; and curing the composition (column 10, line 55 through column 11, line 50).

Gardner et al. do not explicitly disclose: (1) that the composition is strong, workable and easy to apply, flexible, passes ASTM D4068, and cures quickly allowing for flood testing after 24 hours at 70°F. They also do not explicitly disclose that it forms a waterproofing membrane upon curing. However, it appears that the composition of Gardner et al. inherently satisfies all of these property limitations because it satisfies all of the material limitations set forth in the instant invention.

It has been found that, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant

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discloses and/or claims are necessarily present – *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, if not explicitly taught by the reference, then the composition of Gardner et al. would have inherently satisfied the claimed property limitations because the composition of Gardner et al. satisfies all of the material limitations set forth in the instant invention.

***Allowable Subject Matter***

5. Claims 7-9 and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 7, Gardner et al. provide no teaching or suggestion to include an acrylate functional urethane resin in their composition.

Schoenfeld et al. (Pub. No. US 2003/0196753) disclose a similar composition wherein an acrylate terminated urethane resin is added to a composition based on a pre-polymer derived from epoxy resins and amine-terminated polyethers (Abstract). However, the composition does not contain a flexible hardener. The amine-terminated polyether could satisfy the limitation; however, it is fully consumed during the preparation of the pre-polymer (paragraph 0020). Furthermore, these references lack a nexus that would teach or suggest the use of Schoenfeld's acrylate terminated urethane resin in the composition of Gardner et al.

Claims 8, 9, and 16-18 are allowable because they are dependent from claim 7.


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*Communication*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael J. Feely  
Primary Examiner  
Art Unit 1712

June 12, 2006

**MICHAEL FEELY**  
**PRIMARY EXAMINER**